

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

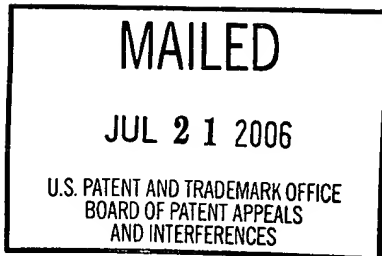
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT C. MAYES

Appeal No. 2006-1461
Application No. 09/653,224

ON BRIEF



Before OWENS, CRAWFORD and FETTING, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1 and 4-15, which are all of the pending claims.

THE INVENTION

The appellant claims a system and method for manufacturing a set of books such that it fits within a particular book storage space. Claim 1 is illustrative:

1. A book manufacturing method, comprising:

identifying a set of books;

receiving a dimension of a book storage space;

selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and

manufacturing the set of books according to the selected format criteria and using the selected page and cover media.

THE REFERENCES

Burton et al. (Burton)	4,598,376	Jul. 1, 1986
Celorio Garrido	6,012,890	Jan. 11, 2000

THE REJECTIONS

Claims 1 and 4-15 stand rejected as follows: under

35 U.S.C. § 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the

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subject matter which the appellant regards as the invention, and under 35 U.S.C. § 103 as being obvious over Celorio Garrido in view of Burton.

OPINION

We reverse the aforementioned rejections.

Rejection under 35 U.S.C. § 112, second paragraph

The examiner argues: "In claims 1, 7, 12, It's not clear the phrase 'selecting format criteria and page and cover media' is with respect to what? Changing the phrase to 'selecting the book format criteria and book page and book cover media' is recommended to improve clarity" (answer, page 3).¹

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of the appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

¹ Claim 7 does not include the phrase "selecting format criteria and page and cover media". Thus, we consider the examiner's rejection of claim 7 to pertain to the phrase "selecting page and cover media as well as format criteria".

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The examiner has not addressed the disclosure throughout the appellant's specification directed toward books and explained why, in view of that disclosure, one of ordinary skill in the art would not have reasonably considered the format criteria, page and cover media in claims 1, 7 and 12 to pertain to books.

Hence, the examiner has not carried the burden of establishing a prima facie case of indefiniteness of the appellant's claims 1, 7 and 12.

Rejection under 35 U.S.C. § 103

Each of the appellant's independent claims (1, 7 and 12) requires that a set of books, once manufactured, will fit within a book storage space having a received dimension.

Celorio Garrido provides books on demand and teaches that some information such as "paper size, font size, and type, which is of great importance for visually challenged people, may be altered by the customer by issuing instructions through the user interaction means 6 according to his/her needs and or desires" (col. 7, lines 9-13), and that "each book may be produced in a plurality of sizes" (col. 7, line 29).

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Burton produces individually tailored suits by cutting appropriately sized parts from a supply of fabric (col. 1, lines 9-11). Burton states that "[t]he manufacturing process need not be limited to a men's suit although certain ones of the manufacturing steps have obviously been described in relation to a man's suit" (col. 11, lines 12-15).

The examiner argues that one of ordinary skill in the art would have applied Burton's made-to-measure technique to Celorio Garrido's book on demand system to obtain the benefits of Burton's technique, which are providing fit and reducing waste and inventory (answer, page 5). The examiner argues that "[a]s for the different [sic] in the type of item, book vs. suit, another particular utility, that is not critical and within the skill of the artisan, manufacturing engineer, as mentioned by GARRIDO [Burton?] above. In other word, mere applying the same manufacturing steps to other similar/equivalent items to obtain similar results would have been obvious to a skilled artisan in the manufacturing art, absent evidence of unexpected results." (Answer, page 6).

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The examiner has not provided evidence that one of ordinary skill in the art would have considered books and suits to be similar or equivalent, or that fitting a suit to a person involves the same manufacturing steps as fitting a book to a shelf. As for Burton's statement relied upon by the examiner (answer, page 5) that the manufacturing process need not be limited to men's suits (col. 11, lines 12-13), the examiner has not established that this statement would have fairly suggested, to one of ordinary skill in the art, applying the process to books versus merely applying it to another clothing article.

Thus, the record indicates that the examiner used impermissible hindsight in combining the applied references to arrive at the appellant's claimed invention. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

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DECISION

The rejections of claims 1 and 4-15 under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 103 over Celorio Garrido in view of Burton, are reversed.

REVERSED

Terry J. Owens
TERRY J. OWENS

Administrative Patent Judge

MURRIEL E. CRAWFORD

Administrative Patent Judge

ANTON W. FETTING

Administrative Patent Judge

BOARD OF PATENT
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